



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

NOV 21 2005

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO IL 60610

In re Application of:

Kieran P. J. Murphy

Serial No.: 09/594,685

Filed: June 16, 2000

Docket: BHG&L 8627/405

Title: **METHOD AND APPARATUS FOR
STRENGTHENING VERTEBRAL
BODIES**

DECISION ON PETITION
UNDER 37 CFR 1.181 TO
REVIEW DENIAL OF ENTRY
OF AMENDMENT

This is a decision on the petition filed on May 9, 2005 under 37 CFR 1.181 to review the denial for the entry of the amendment after final filed February 5, 2005.

The petition is **DISMISSED**.

Petitioner believes that Examiner's position in the Advisory Action mailed March 10, 2005 is unjustified because, in fact, the amendment does not change the scope of the claims, the amendment should not require further search or consideration, the amendment does not constitute new matter, and the amendment places the claims in better form for appeal.

The record shows that in the amendment filed February 5, 2005, applicant proposed changing recitations in the preamble of independent claims 1, 20, and 21 from "vertebroplasty components" to "vertebroplasty and surgical components" and changing "vertebroplasty injection components" to "vertebroplasty injection and surgical components" in independent claim 17. In addition, claims 22 and 23 were converted from previous dependent claims to independent claims but newly adding to the body of the claims "surgical" as in claim 17.

Further, it is noted that each of the claims uses the transitional term "comprising". The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See MPEP2111.03

The phrase, "vertebroplasty and surgical components" or "vertebroplasty injection and surgical components" can convey something different than "vertebroplasty components" or "vertebroplasty injection components", respectively. It has several possible meanings. For

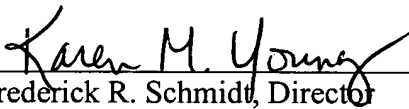
example, "vertebroplasty components" or "vertebroplasty injection components" would appear to convey that all components are vertebroplasty components or vertebroplasty injection components. Since the claims are open-ended, components with non-vertebroplasty features are not excluded and thus one could conclude that the claims additionally cover or encompass a tray having such additional components. However, covering or encompassing a limitation implicitly does not mean that the limitation can be explicitly set forth. In this regard, adding "surgical" raises several issues. Does this mean that all the vertebroplasty components are surgical components or can some be non-surgical as well, such as a camera or a book of instructions or a tray compartment or a sequence of numbers for the location of each vertebroplasty component on the tray? Can it mean that only some are vertebroplasty components and others are non-vertebroplasty components with surgical characteristics? Thus, there are many considerations for the examiner to ponder with respect to new matter. As a new consideration, the changes do not place the claims in better form for appeal. Aside from new matter, the changes may affect the application of the prior art but in view of the issues being raised, this need not be elaborated on as it is clear that there are new issues for consideration by the examiner.

Once a proper final rejection has been entered, applicant no longer has any right to further prosecution, MPEP 714.13, unless an amendment places the application in condition for allowance or in better form for appeal. Neither is seen in this case.

The examiner's position is deemed appropriate and proper.

PETITION DISMISSED.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.

for 

Frederick R. Schmidt, Director
Technology Center 3700